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Filed : May 24, 2001

## REMARKS

### A. Introduction

Applicants respectfully request reconsideration and allowance of this application. Claims 1-30 and 38-43 are pending in the application. Applicants have added new Claim 43, and amended Claims 1, 7-9, 12, 23, 25 and 30 to further clarify Applicants' claimed invention. Applicants' claim amendments and claim additions are shown on the pages above following the heading AMENDMENTS TO THE CLAIMS. On these pages, the [deletions are bracketed] while the insertions are underlined.

Applicants submit that this application, as amended, is now in condition for allowance, and Applicants earnestly request such action. Below, Applicants address each of the Examiner's reasons for rejection.

### B. Applicants' Election

In their Response to the Restriction Requirement mailed on August 27, 2002, Applicants elected, *inter alia*, the species of the rail 24 depicted in Figures 2A, 2B and 2C. In the Office Action, the Examiner withdrew from further consideration pursuant to 37 CFR 1.142(b) Claims 29 and 30 as being drawn to a non-elected species. Applicants respectfully assert that Claims 29 and 30 are clearly drawn to the rail shown in Figures 2A, 2B and 2C, which Applicants have elected. Accordingly, Applicants respectfully request that the Examiner consider and allow Claims 29 and 30.

Also in their Response, Applicants stated that Figures 2A, 2B and 2C all show different views of the same rail. (Spec. page 7, lines 7-9). In the Office Action, the Examiner interpreted Applicants' statement to be an admission on the record that any differences between Figures 2A, 2B and 2C are obvious variants of one another. Applicants respectfully traverse this characterization of Applicants' earlier statement.

Applicants do not understand how, in the context of a species election, different parts of the same article can be compared to one another and declared to be obvious variants of one another. The square holes 46 in Figure 2B, which is a top view of the rail 24, are formed in the upper surface 36 of the rail 24. The oval holes in Figure 2A, which is a front view of the rail 24, are formed in the web 42 of the rail 24. Thus, the square holes and oval holes are merely

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different parts of the same rail. Accordingly, Applicants have not admitted that these differently shaped holes are obvious variants of one another.

**C. Applicants have Addressed the Examiner's Claim Objections**

The Examiner objected to Claims 7-9 and 12 because of certain informalities. Specifically, the Examiner objected to the phrase “with both the upper and lower rails oriented such that... and each picket oriented such that... and a retaining rod resides within...” Applicants would like to thank the Examiner for pointing out this grammatical error. Applicants have amended Claims 7-9 and 12 to correct the error. Accordingly, Applicants respectfully request that the Examiner withdraw these objections.

**D. All Claims Comply with § 112**

The Examiner rejected Claim 23 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically, the Examiner stated that it is unclear what the phrase “alternately insertable” refers to, and it is unclear what element the “corresponding rail” corresponds to.

Applicants have amended Claim 23 to further clarify Applicants’ claimed invention. Claim 23 now clearly recites that the spring clips can be inserted within the first slot or the second slot in the upper rail, and within the first slot or the second slot in the lower rail. Thus, the spring clips are insertable within any of these four slots to suit the preference of the user. Applicants respectfully assert that Claim 23, as amended, complies with the requirements of § 112, second paragraph. Accordingly, Applicants respectfully request that the Examiner withdraw this rejection.

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E. All Claims are Patentable Over the Cited References

Gustafson - § 102 Rejections

The Examiner rejected Claims 1, 3, 4, 8, 14, 21-23 and 25-28 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 2,218,953 to Gustafson. Applicants respectfully disagree with the Examiner's characterization of Gustafson and traverse this rejection.

An anticipation rejection under § 102 requires that "every element of the claimed invention must be identically shown in a single reference." *In re Bond*, 910 F.2d 831 (Fed. Cir. 1990). "There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention." *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565 (Fed. Cir. 1991).

Various preferred embodiments of the present application define, *inter alia*, a picket fence and rail mounting system. The system comprises at least an upper and a lower elongate rail in spaced relation to one another. Each rail has a hollow interior defining a substantially I-shaped cross-section. The substantially I-shaped cross-section has a first surface, a second surface, at least a first slot adjacent the first surface, at least a second slot adjacent the second surface, a plurality of spaced openings in the first surface, and a channel in the second surface. The channel has a width that is at least as wide as the width of each opening. The system further comprises at least one elongate picket having a first end and a second end, at least a first notch or indentation in a picket face, and a cross-sectional shape substantially the same as, but of slightly smaller dimension than the openings in the first surface of the rails. The system further comprises at least one elongate retaining rod disposed within at least one of the rails. The rod cooperates with a notch or indentation on each picket to secure the picket to the rail. The rod is alternately disposable within a first or second slot of the upper rail, and alternately disposable within a first or second slot of the lower rail. Each rail may be alternately oriented such that the first surface resides above the second surface and vice versa.

Various other preferred embodiments of the present application define, *inter alia*, a picket fence and rail mounting system. The system comprises at least an upper and a lower elongate rail in spaced relation to one another. Each rail has a hollow interior defining a substantially I-shaped cross-section. The substantially I-shaped cross-section has a first surface, a second surface, at least a first slot adjacent the first surface, at least a second slot adjacent the second

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surface, a plurality of spaced openings in the first surface, and a channel in the second surface. The channel has a width that is at least as wide as the width of each opening. The system further comprises at least one elongate picket having a first end and a second end, at least a first hole in a picket face, and a cross-sectional shape substantially the same as, but of slightly smaller dimension than the openings in the first surface of the rails. The system further comprises fastening members cooperating with at least one of the holes to secure the picket to the rail. Each rail may be alternately oriented such that the first surface faces upward and such that the first surface faces downward.

By contrast, Gustafson discloses an adjustable grade iron fence. The fence comprises vertical pickets held in vertical position and in proper spaced relation by horizontal upper and lower rails. The upper and lower rails are substantially U-shaped as viewed from the ends thereof. The side walls of the rails are outwardly bowed. The upper surface of each rail includes apertures, which accommodate the vertical pickets. Each picket includes two horizontal slots across a rearward face thereof and adjacent the positions of the upper and lower rails. A locking member comprising a web with a tapering rib is driven into each rail. The locking members prevent the pickets from disengaging the rails.

Gustafson does not disclose a rail having a hollow interior defining a substantially I-shaped cross-section. The Examiner states that Gustafson meets this limitation because the hollow interior of the rail of Gustafson is shaped as the middle portion of an I, which is a substantial portion of an I. Applicants respectfully disagree that the interior of the rail of Gustafson could properly be called substantially I-shaped. On the contrary, the rail of Gustafson is substantially U-shaped, and the interior portion is substantially rectangular, with two sides of the rectangle having outwardly bowed sides.

Applicants' claimed rail has an interior cross-section that is substantially I-shaped. A substantially I-shaped interior of a rail should remind the viewer of an I. The interior of the rail of Gustafson does not remind one of an I. On the contrary, the interior of the rail of Gustafson might remind one of a bowed rectangle. Thus, the interior of the rail of Gustafson is not substantially I-shaped.

There are numerous advantages of a rail having an interior cross-section that is substantially I-shaped. For example, the substantially I-shaped interior forms a plurality of slots that are adapted to accept picket-retaining rods or bars. A picket fence including a rail having a

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substantially I-shaped interior enables a user to arrange the pickets and rails in a plurality of different configurations, as described in Applicants' specification (see, for example, page 13 line 17 through page 14 line 21).

Since Gustafson does not disclose a rail having an interior cross-section that is substantially I-shaped, Applicants respectfully submit that independent Claims 1 and 21 are not anticipated by Gustafson. Dependent Claims 3, 4, 8 and 14, which include the features of independent Claim 1, and dependent Claims 22 and 23, which include the features of independent Claim 21, recite additional features of particular advantage and utility. Moreover, these claims are allowable for substantially the same reasons presented above. Gustafson does not disclose all of the limitations of Claim 1 or Claim 21, let alone the unique combinations of features recited by Claims 3, 4, 8 and 14 or Claims 22 and 23. Accordingly, Applicants respectfully request that the Examiner withdraw these rejections.

Applicants have added new Claim 43, which recites, *inter alia*, a rail having a hollow interior defining an I-shaped cross-section. For the same reasons described above, this limitation clearly distinguishes the fence of Gustafson. Accordingly, Applicants respectfully request that the Examiner allow new Claim 43.

Various other preferred embodiments of the present application define, *inter alia*, a picket fence and rail mounting system. The system comprises an elongate, substantially hollow rail having a top wall with a plurality of spaced openings, and a bottom wall with an elongate channel having a width that is at least as wide as the width of each opening. The rail has a first interior width at a vertical center thereof, and a second interior width at a height just beneath the top wall. The first and second interior widths are measured in a horizontal direction from a first inside surface of the rail to a second inside surface thereof. The second interior width is greater than the first interior width, thus defining an interior elongate slot adjacent the top wall. The system further comprises at least one elongate picket with a notch or indentation in a side of the picket, and a cross-sectional shape sized to fit snugly within one of the openings and the channel. The system further comprises an elongate retaining rod disposed within the slot and the notch or indentation to secure the picket to the rail.

Gustafson does not disclose a rail having a first interior width at a vertical center thereof, and a second interior width at a height just beneath a top wall, wherein the second interior width is greater than the first interior width, thus defining an interior elongate slot adjacent the top wall.

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On the contrary, the rail of Gustafson is wider at a vertical center thereof than it is at either vertical end thereof. Since Gustafson does not disclose such a rail, Applicants respectfully submit that independent Claim 25 is not anticipated by Gustafson. Dependent Claims 26-28, which include the features of independent Claim 25, recite additional features of particular advantage and utility. Moreover, these claims are allowable for substantially the same reasons presented above. Gustafson does not disclose or suggest all of the limitations of Claim 25, let alone the unique combinations of features recited by Claims 26-28. Accordingly, Applicants respectfully request that the Examiner withdraw these rejections.

Gustafson - § 103 Rejections

The Examiner rejected Claims 5-7, 9, 15 and 18 under 35 U.S.C. § 103(a) as being unpatentable over Gustafson. Applicants respectfully submit that these claims are allowable over Gustafson.

In rejecting claims under § 103, the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). To establish a *prima facie* case of obviousness, the following criteria must be met. There must be some suggestion or motivation found in the prior art, either in one or more references or in the knowledge generally available to one of ordinary skill in the art, to modify a prior art reference or to combine reference teachings to meet the limitations of the claim. Further, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991); M.P.E.P. § 706.02(j). “To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” *Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. & Inter. 1985); M.P.E.P. § 706.02(j).

The Examiner stated that Claims 5 and 6 are obvious over Gustafson, because these claims merely represent a rearrangement of the parts of Gustafson, and it has been recognized that the rearranging of parts of an invention involves only routine skill in the art. The Examiner cites *In re Japikse*, 37 C.C.P.A. 1026 in support of his position. Applicants respectfully disagree that *Japikse* applies to Claims 5 and 6.

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In *Japikse*, the court stated that “there would be no invention in shifting the starting switch...to a different position since the operation of the device would not thereby be modified.” *Japikse* at 1031. In Applicants’ picket fence, the position of the notches in the pickets *does* change the operation of the fence over that of Gustafson. The positioning of the notches at different distances from the opposite ends of the pickets enables the pickets to assume a broader variety of aesthetic configurations, as described in Applicants’ specification at page 13, line 17 through page 14, line 21. This operation is not disclosed in or suggested by Gustafson. Thus, the rearranging of the picket notches in Applicants’ rails changes the operation of the pickets over those of Gustafson. *Japikse*, therefore, does not apply. Applicants respectfully assert that Claims 5 and 6 are allowable, and respectfully request that the Examiner withdraw these rejections.

The Examiner also rejected Claims 7 and 9 as obvious over Gustafson, again citing *Japikse*. Applicants’ arguments above with respect to Claims 5 and 6 apply with equal force to this rejection of Claims 7 and 9. Accordingly, Applicants respectfully assert that Claims 7 and 9 are allowable, and respectfully request that the Examiner withdraw these rejections.

With regard to the Examiner’s rejection of Claims 15 and 18, Applicants respectfully point out that these claims depend from Claim 1, which is allowable for the reasons stated above. Moreover, these claims are allowable on their own merit. Gustafson does not disclose or suggest all of the limitations of Claim 1, let alone the unique combinations of features recited by Claims 15 and 18. Accordingly, Applicants respectfully assert that Claims 15 and 18 are allowable, and respectfully request that the Examiner withdraw these rejections.

#### Gustafson in View of Bowls

The Examiner rejected Claim 24 under 35 U.S.C. § 103(a) as being unpatentable over Gustafson in view of U.S. Patent No. 5,557,893 to Bowls. Applicants respectfully submit that this claim is allowable over Gustafson in view of Bowls.

Claim 24 depends from Claim 21, which is allowable for the reasons stated above. Moreover, this claim is allowable on its own merit. Gustafson does not disclose or suggest all of the limitations of Claim 21, let alone the unique combination of features recited by Claim 24. Accordingly, Applicants respectfully assert that Claim 24 is allowable, and respectfully request that the Examiner withdraw this rejection.

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### CONCLUSION

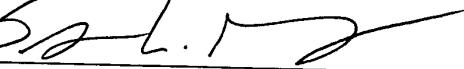
For the reasons presented above, Applicants respectfully submit that this application, as amended, is in condition for allowance. If there is any further hindrance to allowance of the pending claims, Applicants invite the Examiner to contact the undersigned.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 6-13-03

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